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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,480	10/15/2003	Janet A. Warrington	3525.1	8840
22886	7590	09/13/2006	EXAMINER	
AFFYMETRIX, INC ATTN: CHIEF IP COUNSEL, LEGAL DEPT. 3420 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051				LIN, JERRY
		ART UNIT		PAPER NUMBER
		1631		

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/687,480	WARRINGTON, JANET A.
	<b>Examiner</b>	<b>Art Unit</b>
	Jerry Lin	1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 July 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 and 10-13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7-9 and 14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1 page (5/6/2005)</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species A, (claims 1, 2, 7, 8, 9, and 14) in the reply filed on July 10, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Status of the Claims***

Claims 1, 2, 7, 8, 9, and 14 are under examination.

Claims 3-6 and 10-13 are withdrawn as being directed to an unelected invention.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 7, 8, 9, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1 and 8, it is unclear what is meant by "literature attributes." One interpretation is that the "literature attributes" pertain to data regarding the candidate gene. Another interpretation is that the "literature attributes" pertain to the date of publishing or journals. For purposes of this Office Action, the former interpretation will be used.

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5. Regarding claims 1 and 8, it is unclear what is meant by "validation attributes." One interpretation is that "validation attributes" mean that the gene indicates some sort of phenotypic condition. Another interpretation is that "validation attributes" means some sort of statistical analysis is preformed. For purposes of the Office Action, the former interpretation will be used.

6. Claims 1, 2, 7, 8, 9, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of evaluating information. The preambles of the instant claims indicate that the claims are drawn to evaluating information concerning candidate genes. However, there is no step of evaluating in the instant claims. The instant claims only recite collecting information, grouping information, selecting a group, and displaying the information.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 8, 9, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are drawn to a computer program comprising of computer code. However, computer codes are a description or expression of the computer program. Thus the computer codes do not describe any sort of physical object. Furthermore, the computer codes are not in themselves "acts" or "method steps." Thus

the instant claims do not describe a process, composition of matter, or article of manufacture and is not statutory subject matter. Please see MPEP §2106.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 7, 8, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Scherf et al. (Nature Genetics (2000) Volume 24, pages 236-244).

The instant claims are drawn to a method of compiling data related to sample, study, control, data, false negative/positive from experiments, literature, patient, clinical, validation, functional attributes about a candidate gene, selecting a group of attributes and outputting the selected group of attributes.

Regarding claims 1, 2, 8, and 9, Scherf et al. teach a computerized method that includes collecting data related to the sample, study, control, data, and false negative/positive from experiments (abstract, page 243); obtaining data from literature, patient, clinical sources (page 236, right column, bottom, page 237, text of Figure 1; page 237, right column; page 238, text of Figure 2; page 238, left column; page 242, right column); validation and functional attributes about a candidate gene (page 243,

right column, top paragraph); defining at least one groupings of attributes (page 240, right column – page 241); selecting information about the attributes to be evaluated and outputting the information for viewing by a user (page 240, right column – page 241).

Regarding claims 7 and 14, Scherf et al. teach using a oligonucleotide microarray chip (page 243, left column, bottom).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00am-6:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Representatives are available to answer your questions daily from 6 am to midnight (EST). When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199.

  
MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

JL